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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,581	03/20/2006	Karl Ruhland	RUHLAND2	2874
1444 7590 12/30/2008 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
DENTER, CLARK F				
ART UNIT		PAPER NUMBER		
3724				
MAIL DATE		DELIVERY MODE		
12/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/572,581

**Applicant(s)**

RUHLAND ET AL.

**Examiner**

Clark F. Dexter

**Art Unit**

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date 3/20/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II (claims 1, 4-7, 10-12) in the reply filed on September 18, 2008 is acknowledged. The traversal is on the ground(s) that the lack of unity requirement does not comply with PCT Rules 13.1, 13.2 and 13.4. The Examiner respectfully disagrees for at least the following reasons.

Regarding Rule 13.1, each group is directed to a general inventive concept as illustrated by the corresponding special technical feature described in the lack of unity requirement.

Regarding Rule 13.4, the Examiner's position is not that the claims are improper (that is, the subject matter set forth thereby is permissible). Rather, the Examiner's position is that the claims are directed to different inventive concepts and thus constitute a lack of unity.

In the paragraph bridging pages 3-4 of the subject response, applicant argues that

"Under U. S. practice, claim 1 would be called a generic claim."

The Examiner respectfully disagrees. Generic claims apply to species elections. There is no species election requirement in the present application. Rather, under U. S. practice, claim 1 would be called a linking claim.

Further, regarding applicant's contention that claim 1 forms a single inventive concept; that is, if claim 1 is determined to have a special technical feature, then upon allowance of claim 1, rejoinder of the withdrawn dependent claims will be considered.

In the second paragraph of the subject response, applicant argues that 11 claims is not an unreasonable number of claims. However, as stated above, the Examiner's position is not that the claims are improper, but rather that they are directed to different inventive concepts that necessitate a lack of unity election.

In the third paragraph on page 3 of the subject response, applicant argues that there is no undue burden on the Examiner to examine all of the claims. However, each of the dependent claims sets forth specific additional structure that requires separate patentability consideration as well as a separate search, including text searches. It is respectfully submitted that to address these additional matters for each group presents an undue burden to the Examiner.

2. Claims 2, 3, 8 and 9 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made FINAL.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

4. The information disclosure statement filed on March 20, 2006 has been received and the references listed thereon have been considered.

***Oath/Declaration***

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- It is a foreign declaration and has not been executed in accordance with 37 CFR 1.69.

***Drawings***

6. The drawings are objected to because of the following informalities:

In Figure 1, the arrowheaded lead line for each occurrence of numeral 32 is inaccurate since numeral 32 indicates the blade shaft, not the entire assembly as implied, and the lead line for each should be changed to a line that contacts the shaft.

In Figure 2, for the same reason as Figure 1, the lead line for numeral 32 should be changed to a line that contacts the shaft.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Abstract***

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

8. The abstract of the disclosure is objected to because of the use of "means" in lines 11 and 12. Correction is required. See MPEP § 608.01(b).

***Specification***

9. The disclosure is objected to because of the following informalities:

On page 6, line 25, "ribs 42" is inaccurate and should read --grooves 43--.

On page 7, line 24, --(not shown)-- should be inserted after "springs" for clarity.

On page 9, line 13, the underlined "a" is improper and should be replaced with --"a"-- in quotations.

On page 10, line 6, the underlined "b" is improper and should be replaced with --"b"-- in quotations; in line 8, "roll brush" is improper and should read --brush roll--.

On page 11, line 9, the underlined "c" is improper and should be replaced with --"c"-- in quotations.

On page 12, line 3, the underlined "d" is improper and should be replaced with --"d"-- in quotations; in line 9, "plastic part" is unclear and should be changed to read --plastic shell-- for clarity; in line 14, it seems that "the" before "pins" should be deleted since the pins are being first introduced.

On page 13, line 2, "73d" is inaccurate and should read --37d--; in line 4, it seems that "smaller" is inaccurate and should read --larger--; in lines 15, 17 and 28, "18d" is inaccurate and should read --17d--; in line 17, "pin 45" is inaccurate and should be change to --pin 75--.

Appropriate correction is required.

***Claim Objections***

10. Claims 1, 4-7, 10 and 12 are objected to because of the following informalities:

In claim 1, lines 10-13, the recitation "supporting the web of corrugated board ... by the at least one circular blade (34)" is not sufficiently clear as to what is being set forth, and it is suggested to delete the comma "," in each of line 11 and 12, and in line 11 to change "blade shaft (32)" to --at least one circular blade (34)-- for clarity.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 5 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification and drawings do not provide support for grooves that cooperate with ribs for fixing the shells tangentially" as set forth in claims 5 and 12. Rather, support is provided for structure including pins that fix the shells tangentially.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1, 4-7, 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 6-7, the recitation "has at least one circular blade" renders the claim vague and indefinite as to what is being set forth and appears to be inaccurate since the blade shaft does not include (i.e., have) a blade, and it is suggested to insert --thereon-- after "blade (34)" or the like for clarity.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by German Publication 22 25 152 (hereafter GP '152).

GP '152 discloses a device with every structural limitation of the claimed invention including:

a blade shaft (e.g., 1) which has at least one circular blade (e.g., 7), a brush roll (e.g., 9), the brush roll possessing shells (e.g., see Fig. 7) disposed on a roll core (e.g.,

2, 10) and having bristles (e.g., 91, 92), torque-transmitting means and fastening means as claimed.

***Claim Rejections - 35 USC § 102/103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claim 7 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over German Publication 22 25 152 (hereafter GP '152).

GP '152 discloses a device with every structural limitation of the claimed invention including first and second fastening means.

In the alternative, if it is argued that there is no disclosure of such fastening means, the Examiner takes Official notice that such fastening means are old and well known in the art and provide various well known benefits including further stabilizing assembled components. Therefore, it would have been obvious to one having ordinary skill in the art to provide such first and second fastening means on the device of GP '152 to gain the well known benefits including that described above.

***Claim Rejections - 35 USC § 103***

19. Claims 4, 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Publication 22 25 152 (hereafter GP '152) in view of Sauer, pn 3,285,642.

GP '152 discloses a device with almost every structural limitation of the claimed invention but lacks annular ribs and corresponding ring grooves. However, such structure is old and well known in the art and provides known benefits including facilitating non-rotationally connecting a shell to a core. Sauer discloses at least one of many known examples. Therefore, it would have been obvious to one having ordinary skill in the art to provide such rib and ring groove structure on the device of GP '152 to gain the well known benefits including that described above.

20. Claims 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Publication 22 25 152 (hereafter GP '152) in view of Clark, pn 3,942,210.

GP '152 discloses a device with almost every structural limitation of the claimed invention but lacks holes and pins as claimed. However, such structure is old and well known in the art and provides known benefits including facilitating non-rotationally

connecting a shell to a core. Clark discloses at least one of many known examples. Therefore, it would have been obvious to one having ordinary skill in the art to provide such hole and pin structure on the device of GP '152 to gain the well known benefits including that described above. Further, the Examiner takes Official notice that pins as claimed in claim 10 as well as their benefits are old and well known in the art and it would have been well within the skill level of one having ordinary skill in the art to use such pins to gain their well known benefits.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/  
Primary Examiner, Art Unit 3724**

cfd  
December 19, 2008